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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lehman Brothers Inc.

Serial No. 76/226,454

Tamara A. Miller of Leydig, Voit & Mayer, Ltd. for Lehman Brothers Inc.

Ann K. Linnehan, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Seeherman, Chapman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Lehman Brothers Inc. has applied to register the mark RANGERS for "investment brokerage services, namely, brokerage of an equity linked note," in International Class 36. The application is based on applicant's allegation that it has used the mark, and used it in commerce, in connection with the identified services, since March 2001.

The examining attorney refused registration under Section 2(d) of the Lanham Act, arguing that there is a

likelihood of confusion among prospective purchasers of applicant's services, in view of the prior registration of RANGER for "underwriting and servicing insurance," also in International Class 36.

Applicant argued against the refusal, but the examining attorney was not persuaded by the arguments and made the refusal final. Applicant has appealed. Both applicant and the examining attorney have filed briefs. Applicant did not request an oral hearing.

The record includes printouts of information retrieved from the USPTO search system regarding certain third-party registrations, article excerpts retrieved from the NEXIS database, and an affidavit from Josef Muskatel, a senior vice president of applicant. Applicant has not disputed the examining attorney's assertion that the marks are virtually identical and that the difference between the singular and plural forms of a term is insignificant.¹ The evidence made of record all goes to the issue of the relatedness of the services, classes of consumers therefor,

¹ Applicant does cite in its brief to First National Bank in Sioux Falls v. First National Bank South Dakota, 47 USPQ2d 1847, 153 F.3d 885 (8th Cir. 1998), and summarizes that decision as stating, in part, that consumers are more likely to notice what, in other contexts, may be relatively minor differences in names, when selecting financial services. Applicant does not, however, make any direct argument that the marks involved herein are different or that the difference between the singular RANGER and the plural RANGERS is, on its own, significant.

and the channels of trade through which the respective services are marketed.

The examining attorney essentially argues that the marks are virtually identical and that the services are related. On the latter point, the examining attorney relies on the NEXIS evidence and third-party registrations to show that "many companies offer both financial investment and insurance services." Also, the examining attorney notes that applicant has admitted in its brief that "some companies" offer both types of services. Further, the examining attorney asserts that the evidence shows that applicant's services would be within the normal field of expansion for the owner of the cited registration. Finally, the examining attorney asserts that even if, as applicant asserts, prospective purchasers of investment services and insurance services are sophisticated, that does not foreclose the possibility of confusion.

Applicant argues that there is no per se rule that all financial services are related for likelihood of confusion purposes; and that prospective purchasers of applicant's services are looking to make a profit from an investment while prospective purchasers of registrant's services are looking to protect against a loss from a predefined risk.

While acknowledging that some insurance products "have an investment component to them," applicant asserts that, in those instances, the "investment aspect is secondary" to the insurance component. Brief, p. 4, relying on Muskatel affidavit, ¶7.

As to channels of trade, applicant argues that its notes "will be sold directly by Lehman Brothers Inc. or through other broker-dealers to both institutional and retail investors"; that broker-dealers may sell other investment products, but "do not sell insurance products"; and that consumers purchasing insurance do so through insurance agents. Brief, p. 5, relying on Muskatel affidavit, ¶¶ 3, 5 and 6.

As to the sophistication of the involved consumers, applicant asserts that the minimum purchase for its notes is \$1,000 and that "typically investors will not purchase any less than \$10,000 worth of the notes at a time." Likewise, applicant argues that insurance products are expensive, "especially over time." Customers for both applicant's and registrant's services, applicant asserts, exercise care in making purchases not just because of the relative expense of the services but also because they take care in selecting providers of such services.

Finally, applicant argues that it is not aware of any instances of actual confusion, even though the parties' respective services have been contemporaneously marketed under the RANGER/RANGERS marks since March 2001.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, key considerations are the virtually identical nature of the marks, the related nature of the services and, notwithstanding applicant's arguments to the contrary, the overlap in classes of consumers for the respective services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 1103, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

The essential identity of the involved marks makes it likely that, if the marks were used in connection with related services, confusion would result. In this regard,

the Board has stated that "[i]f the marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion." In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983).

Turning, then, to the involved services, we note the well-settled proposition that services need not be identical or competitive to support a finding of likelihood of confusion. It is sufficient if the services are related in some way or the circumstances of their marketing are such that they would be encountered by the same persons, even if not contemporaneously, who would, because of the marks, mistakenly conclude that the services are in some way associated with the same provider, or that there is an association between the providers. In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991); In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

We accept as true, for the purpose of our analysis, applicant's argument that investing services and insurance services serve different basic purposes, i.e., investing is intended to generate wealth, while insurance is intended to maintain or safeguard wealth against risk of loss. We also accept as true applicant's contention that for insurance

products or services that have an investment component, the latter is generally of secondary concern.

On the other hand, we do not agree with the conclusion applicant reaches based on the distinction between investing and insurance, i.e., that the prospective purchasers of the respective services are necessarily different. It seems fundamental that the two services are often marketed to the same individuals. Specifically, those who have attained wealth through investing are candidates for insurance products that will allow them to safeguard the accumulated wealth against loss. Certainly, there are no restrictions in the identifications that would preclude marketing of the involved services to the same individuals.

In addition, we find the excerpts retrieved from the NEXIS database and made of record by the examining attorney suggest that ultimate consumers would be aware that varied investment and insurance services often are available from a single source. See the following examples from among those in the record:

While agreements that restrict an employee's ability to contact former clients are common in many professions, it is only now affecting banks as they get into other financial services arenas such as investment brokerage and insurance...

Milwaukee Journal Sentinel, January 17, 2002.

In recent years, Hibernia has added insurance and brokerage services, as well as an investment banking subsidiary.

The Times-Picayune (New Orleans), December 22, 2001.

The Cedar Rapids, Iowa, firm is a National Association of Securities Dealers member, with securities brokerage, insurance, investment banking and underwriting operations.

The Bismarck Tribune, April 28, 1996.

Also, the third-party registrations that the examining attorney has made of record, which individually cover a number of different financial services and are based on use in commerce, serve to suggest that the listed services are of a type that may emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

Examples of these registrations include the following:

TELLER TRADER SERVICES, Reg. No. 1,988,676, for, inter alia, "financial and insurance services, namely ... brokerage of stocks, options, mutual funds, money market funds, fixed income securities, treasury bills, bonds, notes, CDs, unit investment trusts, investment accounts, and zero coupon bonds ... underwriting and issuance of variable annuities and variable life insurance."

ALL PRO SERIES and design, Reg. No. 2,391,585, for, inter alia, "investment brokerage services; insurance services..."

FOR THE LIFE YOU DESERVE, Reg. No. 2,450,217, for, inter alia, "underwriting insurance for life and disability insurance and annuities ... brokerage in the fields of investments, annuities, insurance, stocks and commodities..."

ESTATE PLANNING SOLUTIONS, INC., Reg. No. 2,459,223, for, inter alia, "investment brokerage services; and

insurance underwriting in the field of life, health, long term care, and disability."

In regard to the relative cost of the involved services and the asserted sophistication of prospective purchasers for the involved services, we note that applicant has acknowledged that its investment notes are sold, among other ways, through broker-dealers directly to retail customers in amounts as low as \$1,000. While the purchase of an investment note for \$1,000 is not an impulse purchase, it clearly can be considered as within reach of many individuals who, for example, choose to save for retirement, a home purchase, or to fund a child's education. Similarly, since there are no restrictions in its identification, we consider the registrant's services to include underwriting and insurance of all types, e.g., car, home, life, and health; and depending on variables such as coverage amounts, deductibles, etc., we consider the services to be available at a wide range of prices to many different consumers. In short, we consider the respective services of the applicant and registrant to be available to many ordinary consumers with varying degrees of sophistication about investments and insurance, not just sophisticated, well-heeled individuals and institutions. See Freedom Savings & Loan v. American Fidelity Assurance

Co., 222 USPQ 71, 74 (TTAB 1984) ("We agree that... the purchasers of group insurance are probably discriminating purchasers. However... since the limitation is not specified in the identification, it cannot be presumed, and purchasers of individual insurance policies would include purchasers at all levels of sophistication.").

We readily acknowledge that purchase of a \$1,000 investment note or a moderately priced insurance policy still would be a purchase made with some degree of care. However, even careful consumers may be confused as to source or sponsorship of these services when, as in this case, they are marketed under essentially the same mark and it is clear, as the record before us shows, that such services can emanate from the same source.

Turning to the channels of trade, applicant asserts that though its investment notes are available to retail consumers through broker-dealers, those broker-dealers do not sell insurance. Muskatel affidavit, ¶5. The basis for the assertion, however, is unclear. We do not know whether applicant is asserting that broker-dealers in notes such as those marketed by applicant do not ever also sell insurance services, or whether applicant is asserting that it markets its notes only through broker-dealers that happen not to also sell insurance services. As to the former

possibility, the NEXIS excerpts and third-party registrations suggest that investment services and insurance services can have a common source. As to the latter possibility, there is no restriction in applicant's identification of services that mirrors the asserted actual trade channel restriction. Accordingly, we must consider applicant's services to be available, or potentially available, through all sorts of sources for investment notes. See Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990), and Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, we do not find the assertion in the affidavit very persuasive.

Moreover, even if we were to assume that the respective services would always be marketed by distinct types of entities, there is still the possibility of confusion if the marks are used by retailers of the respective services to advertise the products. See Freedom Savings & Loan Assn. v. Fidelity Bankers Life, 224 USPQ 300, 304 (TTAB 1984) ("The descriptions before us do not preclude the marks of either party from being used in service promotion to consumers, who may use, at least potentially, both savings and loan association services and

life insurance services; and it is established that self-limitations or limitations imposed by current marketing practices cannot cure this potential for service or trade channel overlap.").

The only remaining point to consider is applicant's assertion that the respective services have been offered under the involved marks contemporaneously since March 2001 and applicant is not aware of any instances of actual confusion. While it is clear from the date of the Muskatel affidavit that applicant is asserting that there have been no instances of actual confusion in the 13 months between the date of first use of the mark and the execution of the affidavit, we have not been provided with any information regarding the extent of sales or advertising of the notes during that time. In addition, applicant has not specified the extent of actual direct sales to consumers vis a vis the extent of indirect sales through retail broker-dealers; nor has applicant provided information about the extent of sales to individuals rather than institutional consumers. In short, the affidavit is lacking in detail and covers only approximately 13 months of contemporaneous use. See *Freedom Savings, supra*, 224 USPQ at 305. (In this September 1984 decision, the Board considered, but accorded little weight to, applicant's allegation of no instances of

actual confusion despite contemporaneous use of FREEDOM for, on the one hand, various financial services involving investing and making of loans, and, on the other hand, insurance underwriting involving policies with investment aspects, because applicant's mark had first been used only in 1982).

In addition, we have not had the opportunity to hear from registrant as to whether it is aware of any incidents of actual confusion. Moreover, because the services are not directly competitive, the type of confusion that would occur would involve misapprehension about source or sponsorship or affiliation, not mistaken purchasing of an investment note when one was seeking insurance, or vice versa. If consumers found both applicant and registrant's services acceptable, any confusion about mutual sponsorship or affiliation would not necessarily be brought to the attention of either applicant or registrant.

Applicant's lack of knowledge of incidents of actual confusion is not particularly probative on the question of likelihood of confusion. Solid evidence of actual confusion is sometimes difficult to obtain and, while it is the best evidence of likelihood of confusion, it need not be present for the Board to conclude that confusion is likely. *See Majestic Distilling, supra*, 65 USPQ2d at 1205

("The lack of evidence of actual confusion carries little weight ...especially in an ex parte context."); *see also* Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992); Block Drug v. Den-Mat Inc., 17 USPQ2d 1315, 1318 (TTAB 1989).

In sum, the marks are virtually identical and, so far as the record reveals, arbitrary when used for the involved services. Despite the fact that the services are not directly competitive, they may be marketed to the same classes of ultimate consumers, through similar channels of trade and at varying price points to consumers of varying degrees of sophistication. Thus, we find a likelihood of confusion to exist.

Decision: The refusal of registration under Section 2(d) of the Lanham Act is affirmed.